Attorney Docket No. 057898-0102

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Danne L. Buchanan, et al.

Title: METHOD AND SYSTEM FOR
                PROCESSING FINANCIAL
                INSTRUMENT DEPOSITS
                PHYSICALLY REMOTE FROM
                A FINANCIAL INSTITUTION

Appl. No.:   09/560,779

Filing Date: 04/28/2000

Examiner: Nga B. Nguyen

Art Unit: 3628

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

     Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

     This request is being filed with a notice of appeal.

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      For purposes of this Pre-Appeal Conference, only claim 103 will be argued. Applicants will argue all of the claims in the formal appeal brief.

FACTUAL DEFICIENCIES IN THE REJECTION OF 10/11/05

An initial comment: The final rejection of 10/11/05 is stated to be responsive to the Communication filed on May 6, 2005, but appears to be using recycled paragraphs directed to claim limitations present several years ago, but no longer in the independent claims. See at least the discussion on page 4 of the rejection on "sending an instruction to a remote site to correct errors," the discussion on page 5 relating to "if no errors are identified, the central site sending endorsement an/or voiding authorization to the remote site," and the discussion at page 5 of the rejection on "associating the endorsed with the voided check image data."

THE CLAIM LANGUAGE IS CLEAR ON ITS FACE AND IS NOT MET BY MAIN REFERENCE GEER (5,930,778) OR THE OTHER REFERENCES

1)   (("a component at the central system for receiving deposit information for a plurality of different deposit transactions, with the deposit information including for each of the different deposit transactions a deposit account designation, electronic check data and check image data for at least one check to be deposited, wherein the central system is separate from MICR capture, deposit accounting, cash management, and float processing systems for a bank of first deposit and wherein the deposit account designation for each of at least a subset of the plurality of the deposit transactions is to a different bank of first deposit;"))

Geer does not disclose any system either in a bank of first deposit system or outside of the processing systems for a bank of first deposit (as is required by the claim) that receives deposit data and image data for a <u>plurality of different</u> banks of first deposit. See Applicants' Response dated May 6, 2005 (we are not aware of what Paper Number this is) at pages 43-46. Geer discloses only a single bank of first deposit 10 receiving checks from the payee (utility company in Geer) that has an account in the bank of first deposit 10. There seems to be a misunderstanding by the examiner of the difference between a bank of first deposit and a payor bank. There would be no reason for a bank of first deposit to receive checks for deposit in payor accounts held in other banks of first deposit.

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2)   Likewise, there is no disclosure in Geer of the bank of first deposit 10, much
less a central system that is part of the processing systems of a bank of first deposit, per the
claim language, receiving checks to be deposited in other banks of first deposit and
performing a transmitting step of the electronic deposit data for each different deposit
transaction of the subset of the plurality of the deposit transactions to a respective different
one of the banks of first deposit. Note that it would make no sense for the bank of first
deposit 10 in Geer to transmit deposit data to other banks of first deposit. Also, note that
this transmitting to a plurality of different banks of first deposit limitation in the claim is
never mentioned in the rejection!

3)   Geer does not disclose a receiving central system that is separate from the
bank of first deposit MICR capture, deposit accounting, cash management, and float
processing systems. Additionally, Geer does not disclose performing at least one of sorting
the received deposit information and error checking the received deposit information in
advance of the MICR capture, deposit accounting, cash management, and float processing
systems of each of the different banks of first deposit designated in the respective deposit
account designations in the deposit information. In Geer, the sorting is performed, as per
the examiner's citation, however, it is performed after appropriate adjustments have been
made to the payee's account balances. See column 9, lines 13-18. Thus, the sorting
operation is not in advance of the bank of first deposit accounting and processing systems.
Geer does not mention error correction, much less when it occurs. Geer cannot meet this
limitation because the Geer element 10 is a bank of first deposit and not a separate central
system in advance of the bank of first deposit. Note that the examiner states that using a
central system in advance of a bank of first deposit is obvious. Applicants' timely traversed
this Official Notice, and requested support in the prior art for this statement under MPEP
2144.03. See Applicants' Response of May 6, 2005, page 48. None was forthcoming in
this 10/11/05 final rejection. The claim language is clear and no reference has been cited to
meet it.

4)   Geer does not have a component in its disclosed bank of first deposit or outside of
that disclosed bank of first deposit for transmitting electronic check data and the check
image data directly or indirectly to a maker bank or a Federal Reserve Bank or a

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correspondent bank with the transmitting being in advance of the MICR capture, deposit accounting, cash management, and float processing systems of the bank of first deposit for that deposit transaction. Rather, the Geer bank of first deposit 10, processes the deposit in its accounting system and makes appropriate adjustments to the payee's account balances, and only then sorts the check information and transmits the check information (no mention is made of check images) to the appropriate payor bank. See Geer at column 9, lines 10-25. See also Applicants' Response of May 6, 2005, pages 46-48. Note that Geer does refer to creating an image of checks for archival purposes and that such image may optionally be transmitted to the bank of first deposit. If the transmission of the check image to the bank of first deposit is optional, it could not be an essential part of a check presentment process to a later bank, i.e., the payor bank. More importantly, if Geer is misconstrued as providing a teaching of optionally transmitting the check image from the bank of first deposit to the maker/payor bank for archival purposes (which it does not), it is a direct teach-away from the claim element that the MICR capture and accounting programs in the bank of first deposit are to be bypassed in the transmission path from the central system to the maker bank. As noted above, Geer teaches that the deposit data is first to be processed in the bank of first deposit accounting system to adjust the payee's account balances, before sending to the payor bank. The advantage of the claim limitation is not only eliminating the delay caused by processing in the systems of the bank of first deposit 10 in Geer, but also the enhancement of security by eliminating the possibility of the insertion of virus', Trojan horses, and other malicious code while the image and attendant data is passing through the computer links and processing of the bank of first deposit.

Campbell is cited for disclosing the transmission of a check image from a bank of first deposit to a payor bank. The single example in Campbell describes a check that has been processed and dishonored at the payor bank, and then an image of the check is sent back to the bank of first deposit. Thus, what Campbell discloses is a bank-to-bank transfer after processing by the sending bank. That is a direct teach-away from the claimed invention, which bypasses the processing systems of the bank of first deposit using a separate central system. Thus, modifying Geer (which transmits check data after processing in its accounting system) with the teachings of Campbell (where the sending bank transmits an image after processing) still does not meet the "transmitting being in advance" claim language for this claim element.

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5)   In addition to the deficiencies noted in the beginning of this Request, the examiner
has failed to consider the Declaration of Mr. Buchanan submitted on May 6, 2005 on
commercial success for this claimed system and its non-obviousness.

        Applicants' believe they have been abused by this prosecution and request an
immediate allowance. If this application is not allowed after this Review, applicants'
formally request a different examiner.

                                        Respectfully submitted,

Date October 21, 2005   By _____

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time
is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No.
19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.

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